

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claim 1 is amended to clarify that second information within the gaps is different from the first information of the respective gap within which the second information is disposed. It is respectfully submitted that no new matter is added, since support for the amendments may be found, for example, at least in Figs. 2 through 4 of the pending application and, for example, at least on page 3, lines 16-19, and 26-28 of the accompanying description in the specification as originally filed.

Claim 24 is amended to depend from claim 1 and to be consistent with amended claim 1. It is respectfully submitted that no new matter is added by way of the amendment since the change merely merges the subject matter of previously presented claims.

Claim 8 remains canceled.

Claims 2-7, 9-23, and 25-27 are left unchanged.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

2. Rejection of claims 1, 2-5, 9, 11, 12, 14, 15, and 17-21 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,688,587 (*Burchard*)

Reconsideration of this rejection is respectfully requested, in view of the amendments to claim 1, on the basis that the *Burchard* patent fails to disclose each and every recited element of amended claim 1. The remaining claims depend from

claim 1, and are therefore patentable as containing all of the recited elements of claim 1, as well as for their respective recited features.

By way of review, the embodiment of amended claim 1 requires a security element having a cover layer with gaps in the form of characters or patterns forming visually and/or machine readable first information. A printed image forming visually and/or machine readable second information is disposed within the gaps in register with the gaps. The content of the second information within the gaps is different from the first information of the respective gap within which the second information is disposed.

Contrary to the embodiment of amended claim 1, the *Burchard* patent fails to disclose content of the second information within the gaps is different from the first information of the respective gap within which the second information is disposed.

Instead, the *Burchard* patent discloses a security element in the form of a metallized thread or band, and a print 8 which is described as being located on metal-free intermediate areas 7.

In observing Fig. 7, which is relied upon in the Office action, the print 8 and the respective gaps 5 in the metallized thread have the same form so that the print 8 can be disposed within the gaps 5 (col. 5, lines 21-25). This is expressly contrary to the requirement in amended claim 1. As explained in the *Burchard* patent, the print and the gaps have the same form so they can be disposed one within the other such that the gaps 5 in the metal layer 4 simultaneously constitute intermediate areas 7 in which the print 8 is applied (col. 5, lines 25-30).

As is shown in Fig. 7, therefore, each of the print 8 and the respective gap 5 within which the print 8 is disposed have the same information content. As discussed above, this is in contrast to amended claim 1, which requires the second information within the gaps is different from the first information of the respective gap within which the second information is disposed.

Accordingly, since the *Burchard* patent fails to disclose the second information within the gaps is different from the first information of the respective gap within which the second information is disposed, as is required by amended claim 1, withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claim 1 is patentable and therefore, claims 2-5, 9, 11, 12, 14, 15, and 17-21, which depend from claim 1, are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective recited features.

3. Rejection of claims 1, 16, and 23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2005/0151368 (*Heim*) in view of U.S. patent 5,688,587 (*Burchard*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to amended claim 1, from which claims 16 and 23 depend.

The requirements of amended claim 1 are discussed above in detail and include the second information within the gaps is different from the first information of the respective gap within which the second information is disposed.

The *Heim* publication discloses a security element 2, 4 applied to a security document and including gaps 9 (Figs. 1 and 8; abstract; paragraphs [0047], [0064], and [0065]).

As acknowledged in the Office action on page 7, the *Heim* publication fails to disclose a printed image forming visually and/or machine readable second information disposed in the gaps, in register, and further wherein the content of the first information and second information is different. Additionally, since the *Heim* publication fails to disclose the content of the first information and second information is different, it follows that the *Heim* publication also fails to disclose the second information within the gaps is different from the first information of the

respective gap within which the second information is disposed, as is required by amended claim 1.

The Office action turns to the *Burchard* patent to cure the deficiencies of the *Heim* publication. However, the shortcomings of the *Burchard* patent are discussed above in detail. Thus, the *Burchard* patent fails to cure the deficiencies of the *Heim* publication.

Accordingly, a *prima facie* case of obviousness cannot be maintained with respect to amended claim 1, from which claims 16 and 23 depend, and withdrawal of this rejection is respectfully requested.

4. Rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 5,573,639 (*Schmitz*)

Rejection of claims 6, 7, and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent application publication 2005/0151368 (*Heim*)

Rejection of claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,344,261 (*Kaule*)

Rejection of claim 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*)

Rejection of claims 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,352,804 (*Sakamoto*)

Rejection of claims 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,688,587 (*Burchard*) in view of U.S. patent 6,352,804 (*Sakamoto*) and further in view of U.S. patent application publication 2005/0151368 (*Heim*)

Reconsideration of these rejections is requested in view of the amendment to claim 1 and the discussion provided above. The claims of the above-identified rejections are dependent from claim 1. It is respectfully submitted that none of *Schmitz*, *Heim*, *Kaule* and *Sakamoto*, make up for the aforementioned shortcomings of *Burchard* as discussed above with respect to amended claim 1, from which all remaining pending claims depend.

In particular, none of the above cited patents and publications discloses second information within the gaps that is different from the first information of the respective gap within which the second information is disposed, as is required by amended claim 1.

Accordingly, it submitted that the proposed combinations of *Schmitz*, *Heim*, *Kaule* and *Sakamoto* with *Burchard*, and *Burchard* alone fail to establish a *prima facie* case of obviousness with respect to amended claim 1, from which all remaining pending claims depend. Therefore, withdrawal of these rejections is respectfully requested.

Response to Official Action of September 10, 2008

Application No.: 10/531,258

Examiner: Pradeep BATTULA

Art Unit: 3722

5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,



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